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# 520 Rec'd PCT/PTO 0 5 OCT 1999.

6715/57089

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Han Min-Jae

Serial No.:

09/319,093

Filed:

May 28, 1999

For:

RECORD/PLAYBACK APPARATUS AND RECORD/PLAYBACK

METHOD

National Stage Processing

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to: Assistant Commissioner for Patents, BOX PCT, Washington, D.C. 20231

JAY H. MAIOLI Reg. No. 27,213 Date 9.30.99

September 30, 1999 1185 Avenue of the Americas New York, NY 10036 (212) 278-0400

### RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE

RECEIVED

Assistant Commissioner for Patents Box PCT Washington, D.C. 20231

2 9 MAR 2000

Sir:

Legal Start Mismational Divisios.

In the Notification of a Defective Response dated September 2, 1999, a copy of which is attached hereto as Exhibit A, it was stated that the application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage. It was also stated that a new oath or declaration, identifying this application by the international application number and international filing date is required. The declaration filed August 16, 1999 allegedly does not comply with 37 CFR 1.497(a) and (b) in that it does not state that "the

person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought." Specifically, the inventor's name Han Min-Jae is not listed as an inventor on the published application.

Applicant acknowledges that the name "Han Min-Jae" is not listed on the published application. Rather, the name "Kan Toshiya" is listed thereon. In actuality, however, "Han Min-Jae" and "Kan Toshiya" are the same person. This discrepancy occurred because the person who translated the Japanese Application into the English language believed the inventor's name should be Toshiya" when, in fact, the translated "Kan as pronunciation and spelling of the inventor's name is "Han Min-Jae."

The inventor's name could be read differently when translating from Korean to Japanese to English, and this U.S. application is based on reading the inventor's name in Korean. Therefore, the inventor of this U.S. Application is the same person as the inventor of the PCT Application.

Because "Han Min-Jae" is the inventor of this U.S. Application and is the same person as the inventor of the PCT Application, it is submitted that the declaration filed on August 16, 1999, in response to Notice of Missing Requirements mailed July 8, 1999, is not defective and properly states that Han Min-Jae believes himself to be the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought. For this reason, it is submitted that a new declaration

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is not required because the declaration filed on August 16, 1999 is in fact accurate.

Also attached hereto as Exhibit B is a STATEMENT OF TRANSLATION OF INVENTOR'S NAME, signed by the official translator in this case, and explaining the name discrepancy. It is believed that this Response in addition to the attached Statement is sufficient to overcome the Notification of a Defective Oath or Declaration.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP

Jay H. Maioli

Reg. No. 27, 213

JHM/RAD

U.S. APPLICATION NO.



### UNITED STA' ... DEPARTMENT OF COMME Patent and Trademark Office

Addition ASSISTANT COMMISSIONER FOR PATENTS

Box PCT Washington, D.C. 20231

FIRST NAMED APPLICANT

5611

6715/57089 ATTY. DOCKET NO.

JAY H MAIOLI COOPER & DUNHAM INTERNATIONAL APPLICATION NO.

NEW YORK NY 10036	- <del> </del>	****			
	I.A. FIENC DATE	PRIORITY DATE			
	0	9/02/99			
•	DATE MAILED:				
NOTIFICATION OF A DEFECTIVE	RESPONSE .				
1. The request for an extension of time (37 CFR 1.136(a)) filed is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)(1)-(a)(5).					
2. Applicant's response filed was received in which is after the expiration of the period for response set in the This application will become abarextension of time to reply to the last Office notification under 37	last Office notification	on mailed nt obtains an			
3. Applicant's response file 6 A 10 1999 included the fo is hereby acknowledged:		ceipt of which			
Copy of the international application in:  a non-English language.  English.  Translation of the international application into English when indicated on the attached Notice of Defective Translation.  Processing fee (37 CFR 1.492(f)) which is insufficient.  Oath or Declaration of inventors(s).  in compliance with 37 CFR 1.497(a) and (b).  Not in compliance with 37 CFR 1.497(a) and (b) for PCT/DO/EO/917.  Surcharge (37 CFR 1.492(e)) which is insufficient.  Copy of Article 19 amendments.  Translation of Article 19 amendments into English.  The International Preliminary Examination Report in English and Translation of Annexes to the International Preliminary Examinal Preliminary amendment(s).  Information Disclosure Statement(s).  Assignment document.  Power of Attorney and/or Change of Address.  Substitute specification.  Statement Claiming Small Entity Status.  Priority Document.	the reasons indicated o	n the attached			
All of the requirements set forth in the notification of MISSING PCT/DO/EO/905 mailed 108 111 1999 have not been complet	REQUIREMENTS (Fo				
Applicant is required to complete the response within a time limit of Notification or within the time remaining in the response set forth in the Form DO/EO/905), whichever is the longer. No extension of this time C.F.R. § 1.136, but the period for response set in the Notification of Mit up to a maximum of six months.	E MONTH from the da Notification of Missing	te of this Requirements			
applicant is reminded that any communication to the United States Paten nailed to the address given in the heading and include the U.S. application	t and Trademark Office on no. shown above. (3	must be 7 CFR 1.5)			
ORM PCT/DO/EO/916 (December 1997)  Notice of Defective Translation  Audult  Telephone: (	Kidwell Parale 703) 305-3050	gal			



## UNITED STATES PAI IENT OF COMMERCE Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS Washington, D.C. 20231

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U.S. APPLICATION NO.		FIRST NAMED APPLICANT		ATTY. DOCKET NO.		
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			DATE MAILED:			

### NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.  does not identify the specification to which it is directed.  does not identify the inventor(s).  does not identify the citizenship of each inventor.  does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought. Han, Min-Japing 15 Dat 15ted as a claimed and for which a patent is sought. Han, Min-Japing 15 Dat 15ted as a claimed and for which a patent is sought. Han I will sted a polication.  FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.
Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:
does not identify the city and state or city and foreign country of residence or each inventor.
does not state that the person making the oath or declaration:
a. has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
b. acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(1)).

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METHOD

August 31, 1999 1185 Avenue of the Americas New York, NY 10036 (212) 278-0400

#### STATEMENT OF TRANSLATION OF INVENTOR'S NAME

Assistant Commissioner for Patents Washington, D.C. 20231

Sir:

I, Kouchi Takasaki, am an official translator of the Japanese language and I hereby certify that I translated into the English language Japanese Application No. 9-270164, filed October 2, 1997. At the time I translated the above Application from Japanese to English, I thought the inventor's name translated into "Kan Toshiya". I now am informed that the proper pronunciation and spelling of the inventor's name is "Han Min-Jae". The inventor's name could be read differently when translating from Korean to Japanese to English, and this U.S. application is based on reading the inventor's name in Korean. Therefore, the inventor of this U.S. Application is the same

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person as the inventor of the PCT Application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Kouchi Takasaki